



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,015	07/31/2000	Aysha Saced	5156-01	6450

7590 09/09/2003
McCormick Paulding & Huber LLP
CityPlace II
185 Asylum Street
Hartford, CT 06103-3402

EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 09/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/630,015

Applicant(s)

SAEED ET AL.

Examiner

Carolyn M Bleck

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 28 June 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 28 June 2003.
Claims 1-15 are pending. Claims 1, 7, and 14 have been amended.

Drawings

2. The proposed drawing corrections submitted 28 June 2003 are accepted.

Claim Objections

3. Claims 1 and 7 are objected to because of the following informalities: at line 2 and line 11 of claim 1, "cerdentialing" and "amd" appears to be grammatically incorrect. For purposed of applying prior art, the Examiner is interpreting claim 1 to recite "credentialing" and "and." At line 10 of claim 7, "said standardized said administrative data format" appears to be grammatically incorrect. For purposed of applying prior art, the Examiner is interpreting claim 7 to recite "said standardized administrative data format." Appropriate correction is requested.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spurgeon (5,890,129) in view of Cullen et al. (6,272,528) for substantially the same reasons given in the previous Office Action (see paper number 4). Further reasons appear below.

(A) As per claim 1-5 and 8-15, Spurgeon discloses a method for exchanging health care insurance, clinical, and business information between insurer and multiple health care providers for efficient administration of services in the health care delivery system comprising:

(a) providing an information-exchange computer (reads on "coordinator system"), also referred to as a web server, wherein local information-exchange software operable on that computer, and in some cases, remote information-exchange software operable on client computers, primary health care provider interface computers and specialist health care provider computers (reads on "medical service provider system"), third party computers or insurer computers (reads on "plurality of practice management agent systems"), wherein the information-exchange computer includes a translator which makes it possible to have automatic transmission and communication of data between computers/systems having incompatible or different and proprietary data formats, wherein the data exchanged includes subscriber demographics, benefit plan, eligibility, prior authorization, claims, quality assurance, and governmental regulatory information, wherein communication between computers is via the Internet, wherein the

client computers connected to the information-exchange computer are provided with interfaces, such as a web browser, for transmitting and viewing data (Abstract, Fig. 1-4, col. 1 lines 5-15, col. 3 lines 1-65, col. 5 line 55 to col. 6 line 24, col. 9 lines 19-35, and col. 10 lines 19-33);

(b) wherein software modules are provided on the computers for the transmitting, receiving, and viewing of data translated from the translator (col. 3 lines 1-16 and 47-65, col. 7 lines 8-52);

(c) wherein functions performed by the third party computers include prior authorization requests, claims processing, explanation of benefits and electronic payment processing (col. 3 line 65 to col. 4 line 18 and col. 10 lines 19-44); wherein the translator includes interface portions for communication between the provider and information-exchange computer and database and data formats (col. 9 lines 19-54); and

(d) wherein the costs reduced by using the system are the cost for hardware and software, costs for translating and formatting incompatible data, costs for manually reentering data between systems (col. 1 line 58 to col. 2 line 67, col. 3 lines 1-65, and col. 9 lines 19-57).

Spurgeon fails to expressly disclose providing to the medical provider system for selection of a first practice management agent system from a plurality of practice management systems, wherein the medical service provider system registers with the coordinator system the selection of the practice management agent system, wherein the coordinator system evaluates security data and authorizes access to administrative

Art Unit: 3626

data, and generating an analysis of the practice management's effectiveness from the coordinator system administrative data to aid the medical service provider in evaluating and selecting the practice management agent system, and wherein the evaluation of effectiveness includes evaluation of price, features, turnaround time, ancillary services, guarantees, and customer service.

Cullen discloses obtaining details of a user's requirements regarding the delivery of financial services and for obtaining financial information from server computers on behalf of the user in light of the user's requirements over the Internet, wherein the user selects the insurance agent which notifies the agent server of the selection, wherein the agent server provides a log-in procedure by which a user can log in to the system, wherein the log-in procedure includes acquiring authentication information such as user name and password, and wherein the agent server validates the information to provide user-specific information, and wherein the recommendations to the user are based on the user's preference and are ordered based on suitability, such as price and features (reads on "neutral evaluation data") (col. 1 lines 5-18 and 45-67, col. 3 line 1 to col. 4 line 35, col. 5 line 55 to col. 6 line 20, col. 7 line 5 to col. 8 line 28, col. 9 lines 49-60).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine the components of Cullen within the method of Spurgeon with the motivation of increasing the speed and cost with which claims are processed and paid, reducing the errors and miscommunications between parties, reducing the time and effort to make updates to software without a requirement for manual reentry of information (Spurgeon; col. 4 lines 41-55) and reducing the cost in

implementing and maintaining the systems by allowing incompatible systems to communicate (Spurgeon; col. 2 lines 4-67).

As per the recitation of "turnaround time, ancillary services, guarantees, and customer service", it is respectfully submitted that in the evaluation of potential vendors, a company typically examines these variables, and the skilled artisan would have found it an obvious modification to include these features within the method taught collectively by Spurgeon and Cullen with the motivation of comparing the relative merits of each vendor (Cullen; col. 1 lines 20-28).

(B) Claims 6-7 appear to be a compilation of the features of claim 1 with the features of claims 2-5 and 8-15, and are therefore rejected for the same reasons given for claims 1-5 and 8-15, in combination.

Response to Arguments

6. Applicant's arguments filed 28 June 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed in the order in which they appear in the 28 June 2003 response.

(A) At pages 4-5 of the 28 June 2003 response, Applicant argues that a *prima facie* case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the

arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that she has at least satisfied the burden of presenting a *prima facie* case of obviousness, since she has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 4). Note, for example, the motivation explicitly stated at the last full paragraph of page 5 of the previous Office Action (i.e., "...the motivation of increasing the speed and cost with which claims are processed and paid, reducing the errors and miscommunications between parties, reducing the time and effort to make updates to software without a requirement for manual reentry of information (Spurgeon; col. 4 lines 41-55) and reducing the cost in implementing and maintaining the systems by allowing incompatible systems to communicate (Spurgeon; col. 2 lines 4-67)") which is based on the teachings of the applied prior art.

(B) In response to Applicant's arguments at pages 6 and 8 of the 28 June 2003 that the prior art fails to teach "the processing of administrative data including billing, reimbursement, credentialing, preauthorization, and collection data", the recitation of "the processing of administrative data including billing, reimbursement, credentialing, preauthorization, and collection data" has not been given patentable weight because the

Art Unit: 3626

recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

(C) At page 5 of the 28 June 2003 response, Applicant argues each of the applied references individually.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Further, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 28 June 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view

of the collective teachings of Spurgeon and/or Cullen, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 4), and incorporated herein.

(D) At pages 5-7 of the 28 June 2003 response, Applicant argues that various features recited in claim 1 are not taught by the applied references.

The Examiner respectfully notes that neither of the Spurgeon and Cullen references were ever applied as references under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits that the issue at hand is not whether the applied prior art specifically teaches the claimed features, *per se*, but rather, whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of these features.

Regarding this issue, it is well established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;

- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In this case, each limitation recited in claims 1-15 has been addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Spurgeon and Cullen based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as clearly detailed in the remarks and explanations given above, and incorporated herein.

As such, it is respectfully submitted that Applicant appears to view the applied references in a vacuum without considering the knowledge of average skill in the art.

Applicant's specific arguments at page 6 of the 28 June 2003 response include an explanation of the limitations recited in claim 1. Applicant states the following: "the Applicant's invention tracks administrative data which includes billing data, reimbursement, credentialing, pre-authorization, and collection data. From this data the system creates neutral evaluation data including price, features, turnaround time, ancillary services, guarantees, and customer service... The tracking of data occurs, in part, while practice management agent systems and physician practice groups use the system to exchange formatted administrative data information."

Firstly, it is noted that the recitation of "the processing of administrative data including billing, reimbursement, credentialing, preauthorization, and collection data" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). It is suggested Applicant incorporate this administrative data into the body of the claim.

Secondly, as per the recitation of creating neutral evaluation data by tracking administrative data", it is noted Spurgeon discloses the information-exchange computer including a translator which makes it possible to have automatic transmission and communication of data between computers/systems having incompatible or different

and proprietary data formats, wherein the data exchanged includes subscriber demographics, benefit plan, eligibility, prior authorization, claims, quality assurance, and governmental regulatory information, wherein communication between computers is via the Internet, wherein the client computers connected to the information-exchange computer are provided with interfaces, such as a web browser, for transmitting and viewing data (Abstract, Fig. 1-4, col. 1 lines 5-15, col. 3 lines 1-65, col. 5 line 55 to col. 6 line 24, col. 9 lines 19-35, and col. 10 lines 19-33), wherein software modules are provided on the computers for the transmitting, receiving, and viewing of data translated from the translator (col. 3 lines 1-16 and 47-65, col. 7 lines 8-52). Spurgeon discloses an architecture for exchanging or "tracking" administrative data. Cullen discloses obtaining details of a user's requirements (reads on "administrative data") regarding the delivery of financial services and for obtaining financial information from server computers on behalf of the user in light of the user's requirements over the Internet, and wherein the agent server validates the information to provide user-specific information, and wherein the recommendations to the user are based on the user's preference and are ordered based on suitability, such as price and features (reads on "neutral evaluation data"), wherein the suitability is based on the user's preferences (reads on "creating") (col. 1 lines 5-18 and 45-67, col. 3 line 1 to col. 4 line 35, col. 5 line 55 to col. 6 line 20, col. 7 line 5 to col. 8 line 28, col. 9 lines 49-60). It is the position of the Examiner that the combination of Spurgeon's system taken with Cullen's information searching and retrieval system would have put the skilled artisan in possession of

Applicant's invention with the motivation of comparing the relative merits of vendors (Cullen; col. 1 lines 20-28).

Lastly, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., objective selection of a practice management agent and plurality of practice management agent systems) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(E) At pages 6-7 of the 28 June 2003 response, Applicant argues that the applied reference Cullen is from non-analogous art and is not combinable with Spurgeon.

In response to Applicant's argument that Spurgeon and Cullen are nonanalogous art, it has been held that a prior art reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992).

The Examiner respectfully submits that the prior art references are reasonably pertinent to the particular problem with which the Applicant was concerned. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant states that the Applicant's physician practice management services are quite different from Cullen's

financial services. However, according to Applicant's specification a practice management agent takes responsibility for billing and collection (pg. 4 lines 20-25). Thus, it is the position of the Examiner that Cullen's financial services are a form of Applicant's physician practice management services, as Applicant's billing and collection are "financial services." Furthermore, Cullen is directed to solving the problem of obtaining information required by a user and then reporting the information back to the user (col. 1 lines 60-67). The present application also seeks to solve a similar problem, namely, to provide a medical service provider with the ability to search for and choose a management system (pg. 4 lines 20-25). Thus, it is the position of the Examiner that Cullen is analogous art as it deals with searching for and retrieving information for a user.

(F) At pages 7-8 of the 28 June 2003 response, Applicant argues that Spurgeon's "insurance computers" and "third-party computers" do not read on "practice management agent systems". Furthermore, the Applicant argues that the claimed "practice management agent systems" have been defined within the specification (pages 1 lines 5-10, pages 2-4).

In response, it is respectfully submitted that the specification citations relied upon by the Applicant do not provide a positive definition of the claimed "practice management agent systems". Instead, the cited passages recite the "practice management agents systems" as providing administrative services for a medical service provider. Spurgeon discloses providing "a third-party review agency that determines

eligibility and authorization" (col. 3 line 66 to col. 4 line 18). The Examiner respectfully submits that Spurgeon's "third party review agency" performs functions that are considered to be forms of Applicant's "administrative services". As such, the Examiner has given the claim language the broadest interpretation and has applied art accordingly.

(G) At page 9 of the 28 June 2003 response, Applicant argues there must be some suggestion or motivation in the references cited to combine the reference teachings according to MPEP 706.02(j).

The Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ

871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

As such, it is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and

reasons indicated by the Examiner both in the present Office Action as well as the prior Office Action, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

(H) At pages 8-9 of the 28 June 2003 response, Applicant argues that the features of claims 2-15 are not taught by the applied prior art.

In response, the Examiner respectfully submits that each limitation recited in claims 2-15 has been addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Spurgeon and Cullen based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as clearly detailed in the remarks and explanations given above and in the previous Office Action (paper number 4), and incorporated herein.

In addition, the Examiner is concerned that, aside from merely alleging that certain claimed features are not obvious from Spurgeon and Cullen, essentially in the form of blanket statements, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out HOW the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346

Art Unit: 3626

F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied prior art teaches a method for extracting pre-defined data items from medical service records generated by health care providers (5,664,109), apparatus and method for providing interactive evaluation of potential vendors (5,765,138), an apparatus and method for processing health care transactions through a common interface (6,112,183), a method and apparatus for evaluating business opportunities for supplying goods and services (5,627,973), and an apparatus and method for processing health care information (6,283,761).

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3626

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306

[Official communications; including After Final communications labeled "Box AF"]

Art Unit: 3626


(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).

CB

CB

September 4, 2003


JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600